



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/221,655	04/01/94	WEISS	S 4575181DJRJP

FLEHR, HOHBACH, TEST
ALBRITTON & HERBERT
SUITE 3400
FOUR EMBARCADERO CENTER
SAN FRANCISCO, CA 94111-4187

18N2/1116

EXAMINER	
DADIO, S	
ART UNIT	PAPER NUMBER
1808	16
DATE MAILED:	

11/16/94

Below is a communication from the EXAMINER in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

- a) ☐ is extended to run _____ or continues to run _____ from the date of the final rejection
- b) ☒ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).
- ☒ Applicant's response to the final rejection, filed 10/24/94 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☒ The proposed amendments to the claim and /or specification will not be entered and the final rejection stands because:
- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
 - b. ☐ They raise new issues that would require further consideration and/or search. (See Note).
 - c. ☐ They raise the issue of new matter. (See Note).
 - d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - e. ☒ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.
3. ☒ Upon the filing an appeal, the proposed amendment ☐ will be entered ☒ will not be entered and the status of the claims will be as follows:

Claims allowed: _____
Claims objected to: _____
Claims rejected: 1-13

However;

- ☐ Applicant's response has overcome the following rejection(s): _____

4. ☒ The ~~affidavit or exhibit~~ request for reconsideration has been considered but does not overcome the rejection because see attachment
5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

- ☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☒ Other Interview Summary attached.

The proposed amendment will not be entered and the final rejection stands. The request for reconsideration has been considered but not found persuasive. A majority of applicants' arguments address the rejections in accordance to the proposed amended claims. However, since the amendments have not been entered applicants arguments are not appropriate because such arguments address limitations which are not present in the pending claims. Accordingly, the reasoning set forth by the Examiner in the previous office actions is maintained.

Applicants argue that Reynolds et al (Rest. Neuro. & Neurosci.) [hereinafter R1] as well as Reynolds et al (Soc. for Neurosci. Ab.) [hereinafter R2] are not proper references because they describe the inventors own work. R1 lists Reynolds and Weiss as authors and R2 lists Reynolds, Tetzlaff and Weiss as authors. While both Weiss and Reynolds are inventors the instant application also names two additional inventors Hammang and Baetge. Thus the references are "by another" because the inventive entity of the instant application differs from the authors of the papers. Query: Tetzlaff is listed as an author but not as inventor. It is recognized that the criteria for inventorship and authorship is not identical but this may raise a question with regard to a rejection under 35 U.S.C. § 102(f). In conclusion, the references are appropriate references.

Applicants also argue that R1 was published between the filing dates of the present application and the filing of

Serial No. 08/221,655
Art Unit 1808

-3-

U.S.S.N. 07/726,812 upon which applicants claim priority. It should be noted that both 07/961,813^{967,622} and 08/221,655 are continuation-in-parts of 07/726,812. Applicants do not obtain benefit to the filing date of 07/726,812 with respect to the new matter which was added in order to create the CIP. Therefore, R1 is deemed an appropriate reference because it was published prior to the filing date of 07/961,813^{967,622}.

The Examiner would like to point out a typographical error which the office action mailed on 7/20/94 contained. Page 7, line 6 should have recited "Gensburger et al does not continue to teach" The term "not" was inadvertently omitted. This is clear considering the Examiner's use of the term "[h]owever" in the subsequent sentence.

The Examiner acknowledges applicants statement that the claims in the instant application closely correspond to U.S.S.N. 08/270,412. In addition, the Examiner has also become aware of the close relation between the instant application and U.S.S.N. 08/010,829. Applicants have the duty to inform the Office and the Examiner of any related application. It is unclear why the Examiner was not made aware of such cases prior to an after final response. However, these issues will be appropriately considered and addressed during the next phase of prosecution.

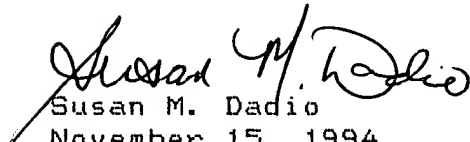
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Susan M. Dadio whose telephone number is (703) 308-2392.

Serial No. 08/221,655
Art Unit 1808

-4-

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

5


Susan M. Dadio
November 15, 1994


MARION C. KNOBE
SUPERVISORY PATENT EXAMINER
GROUP 1800